

DOCKET NO.: **OO-0145
Application No.: 09/707,273
Office Action Dated: May 4, 2011

PATENT

REMARKS

Claims summary

Claims 40, 41, 43, 44, 47-53, 55, 56, 59-65, 67, 71, 73, and 76-81 are pending in the present application. Claims 40, 52, 64, 65, 73, and 79-81 are presently amended. No claims are presently added or canceled.

Office action summary

In the office action of May 4, 2011 (“Office Action”), the examiner issued the following rejections:

- Claims 64, 65, 67, 71, 73, 78, and 81 were rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite.
- Claims 40, 41, 48-53, 60-65, 67, 71, and 79-81 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiser, US Patent 7,263,497 (“Wiser”), in view of Hamada, US Patent 6,792,007 (“Hamada”).
- Claims 43, 55, and 73 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiser in view of Hamada, and further in view of Williams, “MP3 All in One,” Newsbytes, July 23, 1999 (“Williams”).
- Claims 44 and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiser, in view of Hamada, in view of Williams, and further in view of Wolff, US Patent 6,247,047 (“Wolff”).
- Claims 47 and 59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiser, in view of Hamada, in view of Williams, and further in view of Allen, US Publication 2003/0036974 (“Allen”).
- Claims 76-78 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiser, in view of Hamada, and further in view of Doyle, US Patent 5,694,551 (“Doyle”).

The amendments and rejections are discussed below. The examiner is respectfully urged to reconsider the application and withdraw the rejections. Should the examiner have any

questions or concerns that might be efficiently resolved by way of a telephonic interview, the examiner is invited to call applicants' undersigned attorney, Jon M. Isaacson, at 206-332-1102.

Telephonic interview

On June 29, 2011, applicants' undersigned attorney and Allen conducted a telephonic interview. Applicants' undersigned attorney would like to thank the examiner for granting the interview. During the interview, applicants' proposed amendments and arguments were discussed. The examiner agreed to reconsider the arguments following a formal response. Any further substance of the interview is incorporated into the remarks below.

Rejections under 35 U.S.C. § 112

Claim 64 stands rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. More specifically, the examiner asserted that:

Regarding claim 64, Claim 64 recites the elements "means for informing" and "means for placing and indication" that represent means (or step) plus function limitations invoking 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. More specifically, Applicant does not clearly describe what structure or acts are material to the "informing" or placement of the indication. Moreover, assuming said limitations are drawn to program code/software, then the Examiner hereby asserts that Applicant has failed to set forth any algorithm, coding, or the like necessary to perform the necessary functionality.

Office Action, page 7. Without conceding the propriety of the rejection, in an effort to clarify the subject matter recited by claim 64, applicants presently amend claim 64. As amended claim 64 recites an apparatus which comprises "means for transmitting an indication to a consumer station that a music selection is available for transmission to an intermediate storage medium at a consumer site via a music sharing system." Claim 64 also recites that "the consumer station is configured to display an indication within a catalog of the music sharing system that the music selection is available for transmission to the intermediate storage medium."

Applicants respectfully submit that the specification provides structure corresponding to “means for transmitting an indication to a consumer station that a music selection is available for transmission to an intermediate storage medium at a consumer site via a music sharing system,” as recited by claim 64. As one example of structure, the specification describes that “[t]he satellite link (or alternatively the central controller system 36) periodically communicates with each customer household to provide information on available music and program/pricing information.” Specification, page 15 lines 17-20; *see also* Figs. 1, 3, and 4. Applicants submit that this is not the only form of structure provided in the specification; applicants cite to this example here as merely one example of structure provided in the specification. Thus, “means for transmitting an indication to a consumer station that a music selection is available for transmission to an intermediate storage medium at a consumer site via a music sharing system,” as recited by claim 64, should not be construed to cover only the one example of structure explicitly noted in these remarks, but should be “construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof,” as required by 35 U.S.C. § 112, ¶ 6.

For at least the foregoing reasons, applicants submit that the specification describes structure which corresponds to the “means for transmitting an indication to a consumer station that a music selection is available for transmission to an intermediate storage medium,” as recited by claim 64. Accordingly, applicants request reconsideration and withdrawal of the rejection of claim 64 under 35 U.S.C. § 112, ¶ 2.

Claims 65 and 73 stand rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. More specifically, the examiner asserted that:

With respect to claim 65 and 73, similar to independent claim 64, these claims recite means for elements that are not adequately described in Applicant's specification so as to clearly link or associate what is considered the “means for”. As with claim 64, and assuming said limitations are drawn to program code/software, the Examiner again asserts that Applicant has failed to set forth any algorithm, coding, or the like necessary to perform the necessary functionality.

Office Action, page 7. Without conceding the propriety of the rejection, in an effort to clarify the subject matter recited by claims 65 and 73, applicants presently amend claims 65 and 73.

Claim 65, as presently amended, recites, in full: “The apparatus of claim 64 further wherein the central controller system is configured to automatically charge the consumer by automatically charging the consumer electronically.” Claim 73, as presently amended, recites, in full: “The apparatus of claim 64, wherein the music sharing system is a peer-to-peer music sharing system.” Thus, claims 65 and 73 no longer contain “means for” recitations. Because claims 65 and 73 do not contain “means for” recitations, applicants submit that the examiner’s concerns with respect to claims 65 and 73 are now moot. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 65 and 73 under 35 U.S.C. § 112, ¶ 2.

Claims 67, 71, 78, and 81 stand rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite. The rejections of claims 67, 71, 78, and 81 were based solely on the dependence of claims 67, 71, 78, and 81 from claim 64. Inasmuch as claim 64 is not indefinite, as discussed above, applicants submit that claims 67, 71, 78, and 81 are also not indefinite. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 67, 71, 78, and 81 under 35 U.S.C. § 112, ¶ 2.

Rejections under 35 U.S.C. § 103(a)

Claim 40 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiser in view of Hamada. Without conceding the propriety of the rejection of claim 40, in an effort to advance prosecution of the present application, applicants presently amend claim 40. As amended, claim 40 is directed to a method which comprises “transmitting an indication to a consumer station that a music selection is available for transmission to an intermediate storage medium at a consumer site via a music sharing system.” Claim 40 also recites that “the consumer station is configured to display an indication within a catalog of the music sharing system that the music selection is available for transmission to the intermediate storage medium,” and that “the consumer station is further configured to send the consumer request in response to a consumer selection of the music selection without requiring further consumer interaction.” Applicants respectfully submit that, for the reasons which follow, the cited references fail to teach or suggest these recitations of claim 40.

In the Office Action, regarding claim 40, the examiner asserts that:

Regarding claim 40, Wiser teaches a method comprising:

informing a customer that a music selection is available for transmission to an intermediate storage medium at a consumer site via a music sharing system, the informing comprising placing an indication within a catalog of the music sharing system that the music selection is available for transmission to the intermediate storage medium [see at least: col. 13 lines 52-63, col. 19 lines 15-21, Fig. 8, Fig. 9AA #902];

Office Action, page 9. With respect to Wiser, the examiner further asserts that:

Wiser provides an indication as part of a preview process which enables the user to decide whether to purchase the entirety of the song for permanent storage on a hard disk (intermediate storage) of client system and subsequent recording to a CD-R or other portable medium [see at least: col. 13 lines 52-63, Fig. 8]. As part of the preview page, the user is indicated that songs are available for purchase (i.e. permanent storage in hard disk), with the indication including a button (analogous to an icon) which causes the purchase to be effected [see at least: col. 19 lines 15-21, Fig. 9AA #902].

Office Action, page 6. In those portions cited by the examiner, Wiser describes:

Preview: this process is supported by delivery servers 118 and media player 116 to provide a real time streaming of audio data and display of related media data at media player 116. The preview enables the user to decide whether to purchase the entirety of the song for permanent storage on a hard disk of client system 126 and subsequent recording to a CD-R or other portable medium.

...

First, the user views in Web browser 128 some form of menu, catalogue, index or other listing of music and media available for purchase which can be similar in form to the preview listing of FIG. 8. From the user's Web browser 128 (FIG. 1), a purchase request for a specific song is sent to HTTP server 122, for example by the user clicking on a "Buy It" button, in step 902 (FIG. 9A).

Wiser, col. 13 lines 57-63 and col. 19 lines 15-21 (emphases added). As emphasized, Wiser describes a preview which provides “real time streaming of audio data and display of related media data at media player 116” and Wiser describes a “listing of music and media available for purchase.” *Id.* While Wiser may describe that a user may select media data for a streaming preview or for purchase, applicants submit that Wiser does not teach or suggest a user station which sends a request for media data to be transmitted to an intermediate storage medium in response to a consumer selection of the media data without requiring further interaction from the

consumer. Thus, applicants submit that Wiser fails to teach or suggest “transmitting an indication to a consumer station that a music selection is available for transmission to an intermediate storage medium at a consumer site via a music sharing system” where “the consumer station is configured to display an indication within a catalog of the music sharing system that the music selection is available for transmission to the intermediate storage medium” and “the consumer station is further configured to send the consumer request in response to a consumer selection of the music selection without requiring further consumer interaction,” as recited by claim 40.

Regarding Hamada, the examiner asserts that:

In the same field of endeavor, Hamada teaches a system and method for distribution of media content. More importantly, Hamada teaches where the charging is in response to an indication that at least a portion of the media has been stored in a permanent storage medium at the consumer site [see at least: col. 6 lines 36-52, col. 7 lines 53-67, Fig. 14 #s206-208].

Office Action, page 10. Without conceding the propriety of the examiner’s assertion with respect to Hamada, applicants submit that the assertions with respect to Hamada fail to cure the deficiencies of Wiser to teach or suggest “transmitting an indication to a consumer station that a music selection is available for transmission to an intermediate storage medium at a consumer site via a music sharing system” where “the consumer station is configured to display an indication within a catalog of the music sharing system that the music selection is available for transmission to the intermediate storage medium” and “the consumer station is further configured to send the consumer request in response to a consumer selection of the music selection without requiring further consumer interaction,” as recited by claim 40. Thus, applicants submit that Wiser and Hamada, individually and collectively, fail to teach or suggest all of the recitations of claim 40.

For at least the foregoing reasons, applicants submit that claim 40 is patentably defined over Wiser in view of Hamada. Accordingly, applicants request reconsideration and withdrawal of the rejection of claim 40 under 35 U.S.C. § 103(a).

Claim 52 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiser in view of Hamada. Without conceding the propriety of the rejection of claim 52, in an effort to

advance prosecution of the present application, applicants presently amend claim 52. As amended, claim 52 is directed to “[a] computer readable storage medium having computer executable instructions stored thereon.” Claim 52 recites that the instructions comprise “instructions to transmit an indication to a consumer station that a music selection is available for transmission to an intermediate storage medium at a consumer site via a music sharing system” where “the consumer station is configured to display an indication within a catalog of the music sharing system that the music selection is available for transmission to the intermediate storage medium” and “the consumer station is further configured to send the consumer request in response to a consumer selection of the music selection without requiring further consumer interaction.” For at least the reasons that Wiser and Hamada fail to teach or suggest “transmitting an indication to a consumer station that a music selection is available for transmission to an intermediate storage medium at a consumer site via a music sharing system” where “the consumer station is configured to display an indication within a catalog of the music sharing system that the music selection is available for transmission to the intermediate storage medium” and “the consumer station is further configured to send the consumer request in response to a consumer selection of the music selection without requiring further consumer interaction,” as recited by claim 40, applicants submit that Wiser and Hamada fail to teach or suggest “instructions to transmit an indication to a consumer station that a music selection is available for transmission to an intermediate storage medium at a consumer site via a music sharing system” where “the consumer station is configured to display an indication within a catalog of the music sharing system that the music selection is available for transmission to the intermediate storage medium” and “the consumer station is further configured to send the consumer request in response to a consumer selection of the music selection without requiring further consumer interaction,” as recited by claim 52. Accordingly, applicants request reconsideration and withdrawal of the rejection of claim 52 under 35 U.S.C. § 103(a).

Claim 64 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiser in view of Hamada. Without conceding the propriety of the rejection of claim 64, in an effort to advance prosecution of the present application, applicants presently amend claim 64. As amended, claim 64 is directed to an apparatus which comprises “means for transmitting an

indication to a consumer station that a music selection is available for transmission to an intermediate storage medium at a consumer site via a music sharing system” where “the consumer station is configured to display an indication within a catalog of the music sharing system that the music selection is available for transmission to the intermediate storage medium” and “the consumer station is further configured to send the consumer request in response to a consumer selection of the music selection without requiring further consumer interaction.” For at least the reasons that Wiser and Hamada fail to teach or suggest “transmitting an indication to a consumer station that a music selection is available for transmission to an intermediate storage medium at a consumer site via a music sharing system” where “the consumer station is configured to display an indication within a catalog of the music sharing system that the music selection is available for transmission to the intermediate storage medium” and “the consumer station is further configured to send the consumer request in response to a consumer selection of the music selection without requiring further consumer interaction,” as recited by claim 40, applicants submit that Wiser and Hamada fail to teach or suggest “means for transmitting an indication to a consumer station that a music selection is available for transmission to an intermediate storage medium at a consumer site via a music sharing system” where “the consumer station is configured to display an indication within a catalog of the music sharing system that the music selection is available for transmission to the intermediate storage medium” and “the consumer station is further configured to send the consumer request in response to a consumer selection of the music selection without requiring further consumer interaction,” as recited by claim 64. Accordingly, applicants request reconsideration and withdrawal of the rejection of claim 64 under 35 U.S.C. § 103(a).

Claims 41, 48-51, 53, 60-63, 65, 67, 71, and 79-81 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiser in view of Hamada. Claims 41, 48-51, 53, 60-63, 65, 67, 71, and 79-81 depend, directly or indirectly from claims 40, 52, and 64. Inasmuch as claims 41, 48-51, 53, 60-63, 65, 67, 71, and 79-81 depend from claims that are patentably defined over Wiser in view of Hamada, applicants submit that claims 41, 48-51, 53, 60-63, 65, 67, 71, and 79-81 are also patentably defined over Wiser in view of Hamada. Accordingly,

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applicants request reconsideration and withdrawal of the rejections of claims 41, 48-51, 53, 60-63, 65, 67, 71, and 79-81 under 35 U.S.C. § 103(a).

Claims 43, 44, 47, 55, 56, 59, 73, 76-78 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiser in view of Hamada, and further in view of one of Williams, Wolff, Allen, and Doyle. Regarding Williams, the examiner asserts that:

In the same field of endeavor, 892u teaches the advent of Napster.com -- a website/software supporting a virtual community and search engine that makes it a good way to find MP3 files and associated resources. In this regard, 892u teaches where the music sharing system is a peer to peer sharing system.

Office Action, page 13. Regarding Wolff, the examiner asserts that:

In the field of electronic commerce, Wolff teaches the payment of a fee to a sponsor server (operator) by a merchant for advertising [see at least: col. 7 lines 21-25].

Office Action, page 14. Regarding Allen, the examiner asserts that:

In the same field of endeavor, Allen teaches a content distribution system including creating a profile from customer preference information [see at least: 0013, (0075-0080)].

Office Action, page 15. Regarding Doyle, the examiner asserts that:

*In the same field of endeavor, Doyle teaches periodically transmitting updated pricing information for the music selection to the customer station;

wherein the automatically charging the customer for the music selection is done in accordance with the updated pricing information [see at least: col. 4 lines 28-35, col. 5 lines 61-65 (product item update), col. 7 lines 19-24, col. 8 lines 61-67, col. 9 lines 13-21]. Note: the price paid by the customer is the updated price, thus, the customer is charged in accordance with the updated price.*

Office Action, page 16. Without conceding the propriety of any of the examiner's assertions with respect to Williams, Wolff, Allen, and Doyle, applicants submit that Williams, Wolff, Allen, and Doyle fail to cure the deficiencies of Wiser and Hamada to teach or suggest all of the recitations of claims 40, 52, and 64. Thus, applicants submit that claims 40, 52, and 64 are patentably defined over Wiser, Hamada, Williams, Wolff, Allen, and Doyle. Claims 43, 44, 47, 55, 56, 59, 73, 76-78 depend from claims 40, 52, and 64. Inasmuch as claims 43, 44, 47, 55, 56, 59, 73, 76-78 depend from claims which are patentably defined over Wiser, Hamada, Williams, Wolff, Allen, and Doyle, applicants submit that claims 43, 44, 47, 55, 56, 59, 73, 76-78 are also patentably defined over Wiser, Hamada, Williams, Wolff, Allen, and Doyle. Accordingly,

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applicants request reconsideration and withdrawal of the rejections of claims 43, 44, 47, 55, 56, 59, 73, 76-78 under 35 U.S.C. § 103(a).

Conclusion

Applicants believe that the present remarks are responsive to each of the points raised by the examiner in the Office Action, and submit that claims 40, 41, 43, 44, 47-53, 55, 56, 59-65, 67, 71, 73, and 76-81 of the application are in condition for allowance. Favorable consideration and passage to issue of the application at the examiner's earliest convenience is earnestly solicited.

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